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Section IV:
AMENDMENT UNDER 37 CFR §1.121
REMARKS

Error in Office Action Summary

In the Summary of the Office Action (PTOL-326), Item 1 under status, there is an incorrect notation that the Office Action is in response to communications filed on November 16, 2004. This should read that the last communications from the applicant was November 9, 2004. We have also verified through PAIR that Office records show receipt of applicant's last response on November 9, 2004.

For these reasons, applicant requests correction of this date in the record such that any Patent Term Adjustment will be determined from the correct applicant's response date.

Rejections under 35 U.S.C. §103(a)

In the Office Action, claims 1, 10 and 19 were rejected as being unpatentable over a combination of published documents collectively referred to as Odigo and "The Official American Online Tour Guide" (hereinafter "AOL"). Odigo is a combination of two non-patent documents, "Surfing" by Cook, et al., (hereinafter "Cook"), and screen captures of a web site "www.utok.com" as archived by the "Waybackmachine" (hereinafter "WayBack"). Previous rejections based upon "Lee" were withdrawn.

Rejections of Claims 1, 10 and 19 over "Odigo" in view of "AOL"

Treating two documents as a single reference. Applicant traverses the treatment of Cook and UTOK in the rationale for the rejections as being a single reference (e.g. referred to as "Odigo" in the Office Action), as they are clearly separate documents from separate sources, with separate public availability dates. Cook is a printout of a document "Surfing" from the Cook/DuPage/Fox Valley/Lake/McHenry edition of the "Daily Herald", apparently a newspaper. It discusses very briefly 6 different web services from different service providers: Third Voice, Odigo, uTOK, esgear, Instant Rendezvous, Gooley.

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With respect to uTOK, the entirety of the Cook document states only the following very brief overview:

"Unlike Third Voice, uTOK doesn't show the notes on the page itself. The software generates a small, separate window that tells you whether a given site has any public, group or private notes.

Address: <http://www.utok.com>"

With respect to Odigo, the entirety of the Cook disclosure is the following brief statement:

"A program called Odigo also lets you post notes associated with a given page, but that's the least of its abilities. Odigo is Internet radar; it finds the Web sites Odigo users are visiting, helps you locate the user you want to chat with at that site and then enables you to chat with them.

Odigo shows the sites most popular with Odigo users, with a bar graph over each site to illustrate just how popular they are. Once at a site, you can bring up a "radar screen" window that shows you which Odigo users are there.

Address: www.odigo.com

Like Odigo, Goovey and Instant Rendezvous show you ... But they're simpler – you can't filter users by biographical details like with Odigo ..."

The WayBack document containing archived screen shots from the uTOK web site contains no mention of Odigo whatsoever. There is no citation in the Office Action where motivation and suggestion to combine Odigo with uTOK as proposed is found, and thus it is improper to treat them as a single reference, and a *prima facie* case of obvious has not been established.

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Rejections over Cook in view of Wayback in view of AOL. Cook, Wayback, and AOL are very brief, non-patent published documents. For the purposes of rendering the applicant's claims obvious, only the extent of the teachings of these brief documents can be relied upon, and no assumption can be made as to other teachings in other documents. MPEP 2128 states:

Extent of Teachings Relied Upon

An electronic publication, like any publication, may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See MPEP § 2121.01 and § 2123. Note, however, that if an electronic document which is the abstract of a patent or printed publication is relied upon in a rejection under 35 U.S.C. 102 or 103, only the text of the abstract (and not the underlying document) may be relied upon to support the rejection. In situations where the electronic version and the published paper version of the same or a corresponding patent or printed publication differ appreciably, each may need to be cited and relied upon as independent references based on what they disclose.

Additionally, to form effective prior art, these teachings must place the public in possession of enabling disclosure for each and every claimed element, step or limitation. These documents, however, are so brief as only to describe at a feature level what these products allegedly can do. While it is Office procedure to presume *operability* of an apparatus described in a printed reference (MPEP 2121), the presumption of operability is different from whether or not a disclosure is *enabling* (e.g. whether or not the disclosure places the public in possession of the claimed steps, elements or limitations in manner which would allow one skilled in the art to practice the steps, elements or limitations on which the rejection is based):

"Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his [or her] own knowledge to make the claimed invention." *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed Dir. 1985)

Cook and WayBack describe their separate system features in a very brief manner, and AOL describes how to *use* the AOL invention. Neither Cook, nor WayBack, nor AOL describe

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how to *make* their inventions or how each of them achieve their operability, which are key requirements of the enablement definition.

For these reasons, a *prima facie* case of obviousness is not formed by Cook in view of WayBack in view of AOL. Applicant requests reconsideration of the rejections, and allowance of the claims.

Rejections of 2 - 9, 11 - 18 and 20 - 27 in further view of "Internet Everywhere",
alternatively Banks, and alternatively Ferreira

In the Office Action, claims 2 - 9, 11 - 18 and 20 - 27 were rejected under 35 U.S.C. §103(a) over Cook in view of Wayback, in further view of AOL, and in further view of "Internet Everywhere", Banks, or Ferreira. Claims 2 - 9, 11 - 18 and 20 - 27 depend on Claims 1, 10 and 19, respectively.

For the foregoing reasons, Cook in view of Wayback, in further view of AOL, and in further view of "Internet Everywhere", Banks, or Ferreira fails to form a proper *prima facie* case of obviousness, and applicant requests allowance of claims 2 - 9, 11 - 18 and 20 - 27. Should the rejections be maintained, applicant reserves the right to traverse these rejections for reasons in addition to failure to form a *prima facie* case of obviousness.

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